

VIA FACSIMILE - 4 Pages Total

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3162-St-sti 200/113**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : THOMAS GASSNER ET AL.
Serial No. : 09/877,621
Filed : June 8, 2001
For : FIXING LABEL
Art Unit : 1771
Examiner : D. Zirker

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GROUP 1700

April 28, 2003

Commissioner for Patents
Washington DC 20231**RESPONSE TO NOTICE OF NON-RESPONSIVE AMENDMENT**

SIR:

On March 28, 2003, the Examiner mailed a notice that the amendment dated February 23, 2003, was not fully responsive to the Office Action August 22, 2002. Applicants believe that the amendment was, in fact, fully responsive, but supplement it as set forth hereinbelow.

A first alleged defect in the amendment is, as stated by the Examiner, as follows:

"More particularly, applicants have not fully complied with the requirement set forth in paragraph No. 3 or Paper No. 5 requiring the assignee to state which entity is the prior inventor of the conflicting subject matter in each of the two applications referred to."

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In response, Applicants point out Applicants responded to this issue by amending the claims to remove the conflict, i.e., by limiting the instant claims to fixing labels of predetermined length in accordance with the specification at page.6, line 4. Since the requirement was first made because the Examiner determined the two applications contained conflicting subject matter, Applicants submit that a proper and complete response to such requirement was to remove the conflict. The instant claims, thus, are not claiming the same invention as that of copending USSN 09/490,709, and the need for the assignee to state the prior inventor would appear to be moot.

The Examiner says:

“[T]his requirement is nevertheless not considered to be moot, particularly in light of applicants’ statement on page 13 of their response of February 23rd, second complete paragraph wherein they state ‘a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that applicants did not narrow the claims in any material respect.’”

In response, Applicants point out that statement clearly was made in the context of the discussion of the amendments made in response to the rejection under 35 USC § 112, second paragraph, and has no relevance, and certainly no controlling relevance, here.

For the record, the assignee authorizes the undersigned to state that the inventions were made in their order of filing, i.e., the inventors of USSN 09/490,709 made their invention first,

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and then the inventors of the instant application made their invention. In view of (a) the amendment to maintain a clear line of distinction between the two lines of cases and (b) the declaration of common ownership already of record, Applicants will wait with interest to see how the Examiner uses this crucial information since the Examiner opines that this is not, in fact, a moot point.

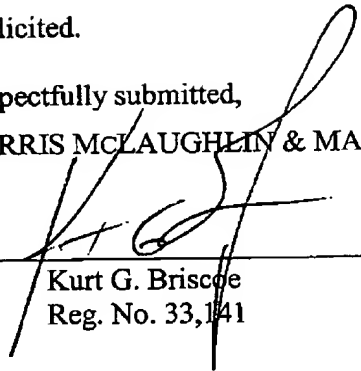
The second alleged defect is, as stated by the Examiner, as follows:

“Although it is noted that applicants have filed a Declaration of common ownership in their response of February 23rd stating that they are the owners of the invention set forth in Serial No. 09/518,463 (which has now been abandoned) they have failed to even mention which entity is the prior inventor of the conflicting subject matter in Serial No. 09/490,709.”

In response, Applicants point out that the only difference between USSN 09/518, 463 and USSN 09/490,709 is that one (09/518,463) was originally filed with the drawing that was later added to the other (09/490,709) by amendment. Consequently, “the invention” in USSN 09/518,463 is identical to that in USSN 09/490,709, and when the assignees said in the Declaration of common ownership that they were the owners of “the invention” of USSN 09/518,463, they, thereby, necessarily also stated that they were the owners of the invention of USSN 09/490,709, the two inventions being the same. Respectfully, this is clear and logical, but, if the Examiner still disagrees, then the undersigned is authorized to state that the assignee was also the owner of USSN 09/490,709 at the time the instant invention was made.

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Early and favorable action is earnestly solicited.

Respectfully submitted,
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GROUP 1700CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Response to Notice of Non-Responsive Amendment (4 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: April 28, 2003By 
Kurt G. Briscoe